

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF OREGON

CALISTA ENTERPRISES LTD, a
Republic of Seychelles Company,

Plaintiff,

vs.

TENZA TRADING LTD., a Cyprus
Company,

Defendant.

TENZA TRADING LTD., a Cyprus
Company,

Counterclaim Plaintiff,

v.

CALISTA ENTERPRISES LTD, a
Republic of Seychelles Company; and
ALEXANDER ZHUKOV,
a Czechoslovakian citizen,

Counterclaim Defendants.

Case No. 3:13-cv-01045-SI

STIPULATED FINAL
CONSENT JUDGMENT AND PERMANENT
INJUNCTION

CONSENT JUDGMENT

This Stipulated Final Consent Judgment and Permanent Injunction is entered into by Plaintiff and Counter-defendant Calista Enterprises Ltd. (hereafter, "Calista") and Defendant and Counterclaimant Tenza Trading Ltd. (hereafter, "Tenza") (collectively, the "Parties"). Whereas the Parties, having considered the facts and applicable law, and have agreed to entry of this Stipulated Final Consent Judgment and Permanent Injunction (the "Consent Judgment"), it is hereby ordered, adjudged and decreed as follows:

Findings of Fact

1. Plaintiff and Counter-defendant Calista Enterprises Ltd. ("Calista") is a Republic of Seychelles company. Calista's business endeavors include the ownership, management and operation of adult entertainment websites at fourteen (14) domains (hereafter, the "Infringing Domains"):

largeporntube.com
goldporntube.com
kissporntube.com
boxporntube.com
pipeporntube.com
69porntube.com
royalporntube.com
bookporntube.com
cubeporntube.com
freshporntube.com
lustporntube.com
bonusporntube.com
directporntube.com
goldporntube.xxx

2. Defendant and Counterclaimant Tenza Trading Ltd (hereafter, "Tenza") is a Cyprus company. Tenza owns a commercial adult entertainment website at www.porntube.com that features photographs, videos, related film clips and other multimedia material (hereafter, "PornTube®").

3. Tenza received a federal trademark registration for its PORNTUBE mark (hereafter, the "Registered Mark") and is the owner of said mark. Its application, made on the basis of actual use in commerce, was filed on October 29, 2008, with a date of first use of May, 2005. The United States Patent and Trademark Office issued Registration Number 3,936,197 for Tenza's PORNTUBE trademark on March 29, 2011.

4. When Tenza discovered that Calista had registered, and was using in commerce, domains that contained Tenza's PORNTUBE trademark, Tenza filed a Uniform Dispute Resolution Procedure ("UDRP") complaint, Claim Number: FA1303001491515, with the National Arbitration Forum, an arbitration entity authorized by ICANN to resolve such disputes.

5. Shortly after Tenza filed its UDRP complaint, Calista filed Cancellation Proceeding No. 92/057,048 with the United States Trademark Trial and Appeals Board (“TTAB”) seeking cancellation of Tenza’s PORNTUBE trademark registration. The TTAB cancellation proceeding was stayed by this Court pending the resolution of the instant litigation.

6. On June 6, 2013, the UDRP Panelists issued a majority decision affirming Tenza’s rights in the mark PORNTUBE and ordering transfer of the Infringing Domains from Calista to Tenza. The UDRP proceeding only addressed 13 of the 14 Infringing Domains as the goldporntube.xxx domain was not identified by Tenza at that time. The Parties have, since, identified a fourteenth Calista-owned domain that utilizes Tenza’s PORNTUBE trademark, goldporntube.xxx, and that domain is included in the list of Infringing Websites.

7. Pursuant to ICANN rules, Calista filed the instant action which had the effect of staying the transfer of the Infringing Domains to Tenza. In its action, Calista alleged causes of action for Declaratory and Injunctive Relief Pursuant to the Anticybersquatting Consumer Protection Act pursuant to 15 U.S.C. § 1125(2)(D)(5), corrected by amendment to 15 U.S.C. § 1114(2)(D)(v), Declaration of Non-Infringement of Trademark, Declaration of No Unfair Competition, and Cancellation of Tenza’s PORNTUBE trademark registration Pursuant to 15 U.S.C. § 1119.

8. Tenza counterclaimed against Calista, alleging causes of action for Infringement of Trademark pursuant to 15 U.S.C. § 1114, Federal Unfair Competition pursuant to 15 U.S.C. § 1125(a), Counterfeiting pursuant to 15 U.S.C. § 1116, Cybersquatting pursuant to 15 U.S.C. § 1125(d), and supplemental claims for Constructive Trust, Accounting and Conversion. Tenza subsequently amended its Complaint to add Alexander Zhukov, a Russian citizen and owner of Tenza, as a counter-defendant.

9. Tenza and Calista filed Answers substantively denying all claims. Tenza has, subsequently, dismissed Mr. Zhukov, with prejudice, from its Counterclaim. It has also dismissed, with prejudice, all of its causes of action against Calista except its causes of action for

Infringement of Trademark and Federal Unfair Competition.

10. The Parties now seek to terminate this litigation through this Consent Judgment, pursuant to a Stipulated Agreement filed under seal concurrently herewith.

CONCLUSIONS OF LAW

11. This Court has jurisdiction over the claims in the Complaint and Counterclaim pursuant to 28 U.S.C. §§ 1331, 1332 and 1367(a). Venue is proper in this Court pursuant to 28 U.S.C. §1391(b). The Court has personal jurisdiction over Tenza and Calista.

12. United States Trademark Registration No. 3,936,197 for the word mark PORNTUBE is valid, subsisting and enforceable, and is neither generic nor descriptive without secondary meaning. Tenza is the owner thereof.

13. Calista has infringed Tenza's common law and statutory rights in the trademark by using the PORNTUBE mark in the names of the Infringing Domains and in material contained on the websites at those domains, including material displayed to Internet visitors to said websites and in meta-tags and other non-displayed materials that are utilized by Internet search engines such as Google, Yahoo and Bing.

14. This Consent Judgment shall finally conclude and dispose of this litigation as between the Parties, and this Consent Judgment shall be entitled to issue and claim preclusion effect.

IT IS HEREBY FOUND, ORDERED, ADJUDGED, AND DECREED THAT:

- A. Tenza is awarded damages against defendant Calista on its causes of action for Infringement of Federally-Registered Trademark and Federal Unfair Competition in the amount of four-million-five-hundred-thousand dollars (\$4,500,000.00), to be paid by Calista pursuant to the Stipulated Agreement filed under seal concurrently herewith.
- B. Calista, including its agents, employees, representatives, parent, subsidiary and related companies, and any person or entity with actual or constructive notice of this

order, is permanently enjoined from use of Tenza's PORNTUBE trademark in any manner that infringes Tenza's rights therein. This paragraph is to be interpreted in conjunction with the definitions and terms contained within the Stipulated Agreement, filed under seal concurrently herewith.

- C. Calista and/or Calista's Domain Registrar are hereby ordered to transfer ownership of the following domains to Tenza, at Tenza's direction, immediately upon receipt of this Order:

largeporntube.com
goldporntube.com
kissporntube.com
boxporntube.com
pipeporntube.com
69porntube.com
royalporntube.com
bookporntube.com
cubeporntube.com
freshporntube.com
lustporntube.com
bonusporntube.com
directporntube.com
goldporntube.xxx

- D. This Court retains exclusive jurisdiction of this action for the purpose of insuring compliance with this Consent Judgment and enforcement of the Stipulated Agreement filed concurrently herewith. Each Party expressly agrees that this Court has personal jurisdiction over it for the purpose of such proceedings, to the extent outlined in (and in conformity with) the Stipulated Agreement, filed under seal concurrently herewith.
- E. No appeal shall be taken by any party from this Consent Judgment, the right to appeal from this Consent Judgment being expressly waived by the parties.
- F. This Consent Judgment shall finally conclude and dispose of all claims and counterclaims of Calista against Tenza and Tenza against Calista with prejudice.
- G. Each party shall bear its own costs and attorney's fees.

H. Final Judgment shall be entered hereto, forthwith and without further notice.

The Clerk is directed to enter this Final Consent Judgment and Permanent Injunction forthwith.

Respectfully submitted,



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IT IS SO ORDERED.

Dated: December 15, 2014



The Honorable Michael H. Simon
Judge
The United States District Court
for the District of Oregon